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No. 95-711

IN THE

Supreme Court of the United States

OCTOBER TERM, 1995

EDWARD L. GUSSIN,

Petitioner,

v.

NINTENDO OF AMERICA INC.

Respondent.

On Writ of Certiorari to the
United States Court of Appeals
for the Federal Circuit

BRIEF IN OPPOSITION TO PETITION FOR A WRIT OF CERTIORARI

Thomas G. Gallatin, Jr.*
Terrence J. Connolly
LATHAM & WATKINS
885 Third Avenue
New York, New York 10022
(212) 906-1200
Counsel for Respondent
Nintendo of America Inc.

* Counsel of Record

Balmar Legal Publishing Department, Washington, DC (202) 682-9800

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QUESTION PRESENTED

Whether the United States Court of Appeals for the Federal Circuit erred in affirming the District Court's grant of summary judgment for defendant/respondent on the alternative grounds that: 1) plaintiff/ petitioner failed to comply with the local rules of the United States District Court for Central District of California requiring him to identify genuine issues of fact that necessitated a trial; and 2) no genuine dispute existed, in any event, with respect to the patent claims in suit.

RULE 29.6
STATEMENT OF AFFILIATED COMPANIES

Pursuant to Rule 29.6 of this Court's rules, respondent states that: 1) Nintendo of America Inc. is a wholly owned subsidiary of Nintendo Company, Ltd., a Japanese corporation whose shares are traded on the Osaka and Tokyo stock exchanges; and 2) Nintendo of America Inc. owns a 51% interest in A/N Inc.

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LOCAL CIVIL RULES OF THE U.S. DISTRICT COURT FOR THE CENTRAL DISTRICT COURT OF CALIFORNIA

Rule 7.9: *Failure to File Required Papers.* Papers not timely filed by a party including any memoranda or other papers required to be filed under this rule will not be considered and may be deemed by the Court consent to the granting or denial of the motion, as the case may be.

Rule 7.14.2 *Statement of Genuine Issues of Material Fact by Opposing Party.* Any party who opposes [a summary judgment motion] shall serve and file with his opposing papers a separate document containing a concise "Statement of Genuine Issues" setting forth all material facts as to which it is contended there exists a genuine issue necessary to be litigated.

Rule 7.14.3 *Determination of Motion.* In determining any motion for summary judgment, the Court will assume that the material facts as claimed and adequately supported by the moving party are admitted to exist without controversy except to the extent that such material facts are (a) included in the "Statement of Genuine Issues" and (b) controverted by declaration or other written evidence filed in opposition to the motion.

RULES OF PRACTICE, UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

Rule 47.6(b) *Nonprecedential opinions and orders* . - Opinions and orders which are designated as not citable as precedent are those unanimously determined by the panel at the time of their issuance as not adding significantly to the body of law. Opinions and orders so designated shall not be employed or cited as precedent. This rule does not preclude assertion of issues of claim preclusion, judicial estoppel, law of the case or the like based on a decision of the court rendered in a nonprecedential opinion or order.

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BRIEF IN OPPOSITION TO PETITION FOR A WRIT OF CERTIORARI

Respondent, Nintendo of America Inc. ("Nintendo"), submits this brief in opposition to the Petition for a Writ of Certiorari to the United States Court of Appeals for the Federal Circuit of Petitioner Edward L. Gussin ("petitioner").[1]

STATEMENT OF THE CASE

Petitioner repeatedly misstates the bases on which summary judgment was granted and affirmed below. In a 36-page

[1] As cited herein, references to the Petition are designated "Pet.", references to the Petition's Appendices are designated "Pet. App." and references to the Excerpts of Record submitted to the Federal Circuit are designated "App. Rec.".

opinion rendered six months before *Markman v. Westview Instruments, Inc.*, 52 F.3d 967 (Fed. Cir. 1995) (en banc), *cert. granted*, 116 S. Ct. 40 (Sept. 27, 1995) (No. 95-26), the district court first held that summary judgment was appropriate because the petitioner had failed to comply with the local rules of the Central District of California requiring him, on pain of dismissal, to identify genuine issues of material fact in response to Nintendo's motion for summary judgment. Pet. App. 16a - 17a.

As is typical across the Circuits, the local rules for the Central District of California require that a party opposing summary judgment file a "separate document containing a concise 'Statement of Genuine Issues' setting forth all material facts as to which it is contended there exists a genuine issue necessary to be litigated" and further provide that failure to comply would result in entry of summary judgment. Local Civil Rules of the Central District of California, Rules 7.14.3; 7.9; 7.14.2. Despite these rules, and Ninth Circuit case law affirming summary judgment for failure to comply with them, petitioner's opposition failed to set forth any specific facts allegedly in dispute with respect to claim construction or any other issue in this patent infringement suit.

Prior to argument of the summary judgment motion, the district court served the parties with a tentative opinion which, *inter alia*, pointed out petitioner's procedural failings. During argument, the district court repeatedly asked petitioner's counsel to identify any evidence sufficient to raise a disputed issue of material fact. App. Rec. 1447, 1450, 1466. Petitioner's counsel was unable to do so, arguing instead that summary judgment was inappropriate because unidentified "technical" matters had to be decided. App. Rec. 1449, 1452-53, 1463-64, 1467. The district court even offered to adjourn the argument to allow petitioner's counsel additional time to identify any disputed issue of material fact. Petitioner's counsel declined. App. Rec. 1456. Noting that petitioner's opposition fell "far short of what is contemplated by

the rules", the district court granted summary judgment on this first independent ground. Pet. App. 16a.

The Court of Appeals correctly affirmed the district court's dismissal on this basis, as one of two alternative grounds for affirmance, holding "[w]e agree with the district court that summary judgment was appropriate because Gussin's 'Statement of Genuine Issues of Material Fact' was deficient." Pet. App. 4a-5a.[2]

Even though petitioner had failed to specifically set forth any factual dispute in compliance with the local rules, the district court carefully proceeded to evaluate petitioner's arguments in opposition to the motion for summary judgment. As a result of its analysis, the district court granted summary judgment on petitioner's literal infringement claim on four additional and independent grounds because the accused Nintendo device did not contain any of four separate claim elements required by the asserted patent. Pet. App. 17a - 38a.[3]

As an alternative basis on which to affirm the grant of summary judgment, the Federal Circuit concurred with the district court's holding that there was no genuine issue of mate-

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[2] The Federal Circuit designated its opinion as not citable as precedent pursuant to Federal Circuit Rule 47.6(b). Such opinions are "those unanimously determined by the panel at the time of their issuance as not adding significantly to the body of law."

[3] The district court held that the explicit language of the claims, the specification, and the prosecution history each demonstrated that the asserted claims required a pixel memory that stores actual color data, and not just pointers to a separate, second color memory where the actual color data is stored. Pet. App. 23a - 27a. Because there was no genuine dispute that Nintendo's product did not contain a pixel memory that stored actual color data, the district court granted summary judgment of no literal infringement.The district court also granted summary judgment on the alternative bases that: 1) Nintendo's computer-based product was not a dedicated, hardware-based "video art electronic system" as required by the patent

rial fact regarding the claimed pixel memory element of the patent and stated that it did not need to reach the additional three grounds on which the district court granted summary judgment. Pet. App. 5a - 11a. The Federal Circuit cited its recent *Markman* decision to support its conclusion with respect to the pixel memory element that the "alleged conflicting opinions of both parties' experts do not create genuine issues of fact precluding summary judgment as to the meaning of the claims at issue." Pet. App. 6a. On the facts of this case, this conclusion was fully consistent with the Federal Circuit's pre-*Markman* precedent cited by the district court to the effect that conclusory expert declarations that conflict with the public patent record do not raise genuine issues of fact. See Pet. App. 18a-19a; 21a-22a; 26a-27a; 30a; 33a; 36a-37a, citing, e.g., *Johnston v. IVAC Corp.*, 885 F.2d 1574, 1579-80 (Fed. Cir. 1989) (although a genuine evidentiary conflict may be created pertinent to a claim's interpretation, "[c]onflicting opinions on the meaning of a term which are merely conclusory do not create such evidentiary conflict.").

The district court further ruled that petitioner could not rely on the doctrine of equivalents to expand the scope of his claims because, *inter alia*, he was, as a matter of law, estopped from expanding the literal scope of his claims. Pet. App. 21a-22a, 30a, 32a-35a; citing, *inter alia*, *Haynes Int'l, Inc. v. Jessop Steel Co.*, 8 F.3d 1573, 1579 (Fed. Cir. 1993) ("The legal standard for determining what subject matter was relinquished is an objective one, measured from the vantage point of what a competitor was reasonably entitled to conclude, from the prosecution history,

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claims; 2) the accused product did not have two "joysticks," or two "moveable members," the physical position of which directly controlled drawing and coloring, as required by the claims; and 3) the accused product lacked a two-position "draw switch" having a first position for drawing and a second position for not drawing as required by the claims. Pet. App. 19a-23a; 27a-35a.

that the applicant gave up to procure issuance of the patent."); *Jonsson v. Stanley Works*, 903 F.2d 812, 817 (Fed. Cir. 1990) (the prosecution history "limits the interpretation of claims so as to exclude any interpretation that may have been disclaimed or disavowed during prosecution in order to obtain allowance.").

The Federal Circuit correctly affirmed the district court's holding that petitioner was estopped from relying on the doctrine of equivalents by his unequivocal and undisputed statements in the patent prosecution which limited the patent to systems with a specific type of pixel memory not present in the accused product. Pet. App. 10a-11a, citing *Southwall Technologies Inc. v. Cardinal IG Co.*, 54 F.3d 1570, 1579 (Fed. Cir. 1995).

Contrary to the Petition, the district court did not "disregard[ ] the disputed issues of fact identified by petitioner . . . [and] construe Gussin's patent claims as a matter of law" under the banner of the Federal Circuit's *Markman* decision. Pet. at 4. After pointing to petitioner's default in his obligation to demonstrate issues of disputed fact, the district court undertook its own analysis of the record and rendered its decision pursuant to pre-*Markman* cases. These cases allowed for the possibility that there might be disputed issues of fact with respect to claim construction that could preclude summary judgment. The district court examined petitioner's purported "evidence" and found that it did not raise a genuine issue of material fact:

> Gussin . . . argues that factual disputes over claim interpretation preclude summary judgment. Of course, genuine material factual disputes *always* preclude summary judgment; what is missing here is a genuine factual dispute . . . . Gussin contends that when "technical-terms" are in dispute, a genuine issue of fact is presented. The authority he relies on, however, requires that there be a *genuine dispute* or uncertainty as to the meaning of a claim term. Gussin fails to offer evidence, aside from conclusory affida-

> vits, of any genuine dispute or uncertainty as to any technical term here. As stated in *Johnston*, "conflicting opinions on the meaning of a term which are merely conclusory do not create [the required] evidentiary conflict."

Pet. App. 36a, (emphasis in original), citing *Johnston v. IVAC Corp.*, 885 F.2d 1574 (Fed. Cir. 1989).

The Federal Circuit similarly analyzed petitioner's proffered "evidence" and concluded (apart from petitioner's procedural default under the local rules) that the district court had properly granted summary judgment. *See, e.g.*, Pet. App. 9a (pointing out Gussin's incomplete quotation of the patent examiner's statement); Pet. App. 10a (noting that Gussin had miscited Nintendo's witnesses' declarations and depositions and concluding that there was no genuine issue of material fact necessitating trial).

SUMMARY OF ARGUMENT

The Federal Circuit affirmed the district court's grant of summary judgment on a first, independent ground that petitioner's opposition to the motion failed to comply with the local rules of the Central District of California, which explicitly warned that such a failure would result in a grant of summary judgment. As a case which was disposed of because of a willful, procedural default, this case does not merit review by this Court. The default was clear and undisputed under a routine local rule. Because this Court's disposition of *Markman* cannot affect the judgment entered for respondent on this ground, the Court should deny the Petition for a Writ of Certiorari.

Nor does the Federal Circuit's citation of its *Markman* decision in support of its alternative holding that the accused product lacked the requisite pixel memory element raise any Seventh Amendment issue that should be reviewed in this case. The Federal Circuit correctly affirmed the district court's pre-

Markman decision that no genuine dispute was presented by the record that required a trial.

REASONS TO DENY THE WRIT

The Federal Circuit's affirmance of summary judgment on the ground that petitioner had violated the district court's local rules is itself an independent and adequate basis for that decision. Although the Federal Circuit proceeded to examine the merits of the motion, that alternative holding was unnecessary to its affirmance of the district court judgment:

> The [district] court granted summary judgment in favor of Nintendo because Gussin's "Statement of Genuine Issues of Material Fact" was procedurally deficient and violated the court's local rules. In particular, the court found that Gussin "fail[ed] to specifically identify, in an intelligible manner, [the] facts asserted to be disputed and specific evidence in support of those assertions." . . . . We agree with the district court that summary judgment was appropriate because Gussin's "Statement of Genuine Issues of Material Fact" was deficient. Gussin simply asked nine vague questions that do not set forth evidence that raises a disputed issue of material fact.

Pet. App. 4a-5a (citation omitted).[4]

Petitioner does not argue that this sufficient basis for the Federal Circuit's affirmance presents any ground on which this

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[4] For example, Gussin queried the Court:

> Shouldn't the jury as trier of fact decide whether Dr. Ward [a Nintendo consultant and expert witness in this case] should be given any credibility since he admits he has been paid over $380,000 by Nintendo over the past five years, and presently earns at least $8,000 per month from Nintendo, whether he does any work or not?

App. Rec. 478.

Court should issue a writ of certiorari. In light of its fact-bound nature unique to the circumstances of this case, it indisputably does not. Because petitioner's procedural failings are an adequate and independent basis for the judgment below, no Seventh Amendment issue should be reached in this case. *Ashwander v. Tennessee Valley Auth.*, 297 U.S. 288, 346-47 (1936) (J. Brandeis concurring: "[I]f a case can be decided on either of two grounds, one involving a constitutional question, the other involving a question of statutory construction or general law, the Court will decide only the latter"). *See Escambia County, Florida v. McMillan*, 466 U.S. 48, 51 (1984) (*per curiam*) ("normally the Court will not decide a constitutional question if there is some other ground on which to dispose of the case"); *Globe Liquor Co. v. Four Roses Distillers Co.*, 404 U.S. 873 (1971) (denying certiorari because lower court ruling rested on independent and adequate state ground); *Alma Motor Co. v. Timken-Detroit Axle Co.*, 329 U.S. 129 (1946) (Court refused to decide the constitutionality of a federal statute because of the presence of nonconstitutional issues that alone might have constituted an adequate ground for deciding the case).[5]

Nor would the Federal Circuit's alternative ground for granting summary judgment, standing alone, present any Sev-

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[5] Petitioner wrongly suggests that the Court of Appeals and district court did not rely on petitioner's violation of the local rules as an independent ground for their decisions. Pet. 11, at n. 11 and accompanying text. The opinions of both the Court of Appeals and the district court explicitly hold that petitioner's procedural failing was a sufficient, independent basis for granting summary judgment. Pet. App. 4a; 16a-17a.

Petitioner's argument that he was unfairly surprised by the requirements of the district court's local rules was properly rejected by the Federal Circuit in light of the unambiguous requirements of the rules and the multiple opportunities petitioner was given to identify genuine issues of material fact. *See* pp. 1-3, *supra*; *Nilsson, Robbins, Dalgarn, Berliner, Carson & Worst v. Louisiana Hydrolec*, 854 F.2d 1538 (9th Cir. 1988) (local rule such as Central District of California Civil Rule 7.14.3 provides adequate notice that a party must identify genuine issues of fact and support it with evidentiary material). (Con't.)

enth Amendment issue for this Court's review. While the Federal Circuit cited *Markman*, it adopted the district court's analysis (prior to *Markman*) that there were no genuine issues with regard to the pixel memory element of the patent in any event. Pet. App. 6a, citing *Markman*, 52 F.3d at 983. *See Johnston v. IVAC Corp.*, 885 F.2d at 1579-80 ("Conflicting opinions on the meaning of a term which are merely conclusory" do not create a genuine evidentiary conflict precluding summary judgment); *Barmag Barmer Maschinenfabrik AG v. Murata Mach., Ltd.*, 731 F.2d 831, 836 (Fed. Cir. 1984) (same); *Senmed, Inc. v. Richard-Allan Medical Indus.*, 888 F.2d 815, 819 n.8 (Fed. Cir. 1989); *Haynes International, Inc. v. Jessop Steel Co.*, 8 F. 3d at 1578; *Jonsson v. Stanley Works*, 903 F.2d at 817. The Federal Circuit did not need to address the question of whether it had the right to resolve genuine disputes over the meaning of the claim terms in this case because, as the district court had noted, there were no such disputes presented: Gussin's proffered "evidence" was based on misstatements of the language of the patent and the prosecution history. Pet. App. 6a-9a.

Nor did the Federal Circuit resolve factual disputes with respect to the question of infringement, as the petition asserts. Pet. at 15. Again, the court explicitly examined petitioner's "evidence" and correctly affirmed the district court's holding that petitioner had misrepresented that evidence and that there was no genuine dispute as to how the accused product operated. Pet. App. 10a ("Gussin claims that Nintendo's expert witnesses admitted in their declarations and during depositions that the SNES stores actual color data. However, the declarations indicate instead that the pixel memory in the SNES device stores pointers rather than actual color data, and the deposition testi-

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Petitioner's failure to identify any disputed issue of material fact confirmed the district court's conclusion that Gussin's failure to comply with the local rules "appear[ed] to be caused by a lack of evidence in support of Plaintiff's complaint." Pet. App. 17a.

mony relied upon by Gussin is not inconsistent with those declarations.").

This is a simple case in which petitioner violated the district court's local rules and could not identify any genuine issue of fact necessitating a trial. It presents no Seventh Amendment issue for the Court's review, but rather a unique record applicable only to petitioner. On this record, there is no basis on which the question presented by the Petition could be addressed in this case. There is no basis to grant a writ of certiorari in this case, nor to defer the Petition pending this Court's decision in *Markman*. The Petition should immediately be denied.

CONCLUSION

For each of the reasons set forth herein, the Petition should be denied.

Respectfully submitted,

Thomas G. Gallatin, Jr.*
Terrence J. Connolly
LATHAM & WATKINS
885 Third Avenue
New York, New York

Counsel for Respondent
Nintendo of America Inc.

*Counsel of Record